

REMARKS

The withdrawal of objections and rejections in the prior Office Action as set forth by the Examiner on page 2 of the current Office Action is acknowledged.

It is noted that the Office Action Summary refers in the "Status" section to the Office Action being "Responsive to communication(s) filed on 14 June 2004." It is believed that the communications to which the Office Action is responsive are those filed by Applicants and dated March 22, 2004 ("Amendment") and April 26, 2004 ("Supplemental Amendment"). The Office Action is dated June 12, 2004 on its signature page and was mailed June 16, 2004 and, therefore, cannot be responsive to a communication filed 14 June 2004. The substance of the Office Action appears to address the communications filed by Applicants identified above.

A further clarification of the pending and withdrawn claims is required in view of an inadvertent error by Applicants in the prior Amendment dated April 26, 2004. In that Amendment, in response to a restriction requirement, Applicants elected the claims of Group I. However, the undersigned misidentified the claims encompassed by Group I as set forth by the Examiner in the Office Action mailed September 30, 2003. The claims of Group I set forth by the Examiner were "Claims 1-34, 39-43, 50-64 drawn to peptides and pharmaceutical compositions, classified in Class 514, subclass 17." (*Id.*, page 2) In the amendment dated April 26, 2004, Applicants stated that the claims of Group I were "claims 1-20, 25-31 and 38-40." (Remarks, page 82) The effect of that error is insubstantial since both the Examiner and Applicants have addressed the issues relating to the claims of Group I. Dependent claims 21-24 and 32-34, drawn to compounds should be included in Group I and claims 38 and 44-49, drawn to methods should not be included. Since claims 21-24 and 32-34 ultimately depend from claim 1, Applicants have treated

the present Office Action effectively to include those claims and to exclude the method or use claims. The undersigned apologizes for the confusion caused by this inadvertent error and requests the Examiner to correct the record for purposes of future actions in this application.

Claims 1-34 and 50 have been canceled for purposes of advancing prosecution of the instant application only. Applicants maintain that these claims are patentable and will re-present said claims in a continuing divisional application shortly to be filed. Similarly, claims 35-38, drawn to process of use or method of treatment and directly or indirectly dependent from canceled claim 1 are similarly canceled, subject to re-presentation in a divisional application.

Claim 42 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner remarks that the phrase "still additionally" appearing in the claim is indefinite. While this phrase is understandable and definite in the context of the pending claim, in the interest of advancing prosecution it has been amended to use equivalent language by replacing the cited phrase with the word "further" so that the relevant portion of the claim now reads, "further containing." No narrowing of amended claim 42 intended, and no narrowing has occurred as a result of this amendment. Entry of the amendment is respectfully requested. Withdrawal of the rejection of claim under 35 U.S.C. § 112, second paragraph, is respectfully requested.

The specification is objected to in view of gaps and blank spaces on pages 13, 14, 16, 24, 30, 34, 94, 96, 99, 101-103, 128, 141, 281, and 288. The Examiner states that such gaps and blank spaces indicate that text is missing from the present application. This objection is traversed.

Rather than "indicating" that text is missing, it is observed that the gaps and blank spaces occur in connection with

extensive listings of chemical structures, such as at pages 13, 14, 16, 24, 30 and 34; in connection with a display of reaction sequences for synthesis schemes and examples, such as at pages 94, 96, 99, 101-103, 128 and 281; and prior to beginning a lengthy table of results, such as at pages 141 and 288. It is respectfully suggested that it would be apparent to one skilled in the art reading the patent that such blanks are merely a consequence of formatting for the reasons noted above. Furthermore, Applicants' anticipate that, since a patent application ordinarily requires re-formatting for the convenience of publication, both as a published application and after allowance, the above-noted gaps and blank spaces will be minimized or eliminated in the course of processing by the Patent and Trademark Office. In this regard, the Examiner's attention is invited to the published application corresponding to the present application, US 2003/0216325 A1. For the Examiner's convenience, a copy of the cover page and pages 1-7 inclusive are attached as support for Applicants' argument. The gaps and spaces in pages 13, 14 and 16 of the application as filed that are cited by the Examiner have been re-formatted by the Publications Branch in the process of publishing the application. The relevant portions corresponding to pages 13, 14 and 16 appear at pages 6 and 7 of the published application. These portions are provided as examples since it was not considered necessary to submit each published page corresponding to the pages cited by the Examiner. However, if the Rules so require, then Applicants are prepared to file a substitute specification with the identified gaps and blank spaces reduced to the extent reasonably possible. Withdrawal of this objection is respectfully requested.

The provisional double patenting issue raised by the Examiner is moot in view of the cancellation of claim 1.

Finally, it is noted that the Examiner has concluded that claims 39-41, 51-64 and 66-89 are allowable, and, following the editorial amendment to claim 42 referred to above, that claims 42 and 43 are also expected to be allowable. Consequently, it is respectfully requested that, in addition to these claims, the "method" or "use" claims, using or comprising the compounds to which the allowable claims are directed, specifically claims 44-49, as well as claim 65 (reciting use of the same compounds as in claim 61) and claim 90 (reciting the same compounds as in claim 86), should similarly be allowed. It is respectfully suggested that this will promote the efficient use of the time and assets of the Office as well as Applicants. Due consideration of this proposal is earnestly solicited.

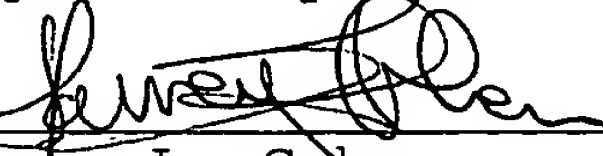
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this response, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: December 16, 2004

Respectfully submitted,

By 
Harvey L. Cohen
Registration No.: 28,365
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant